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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,606	12/08/2003	Yuko Takeda	60395 (49381)	4761

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EDWARDS & ANGELL, LLP
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BOSTON, MA 02205

EXAMINER

TRAORE, FATOUMATA

ART UNIT	PAPER NUMBER
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2112

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/731,606	TAKEDA ET AL.	
	Examiner	Art Unit	
	Fatoumata Traore	2112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/08/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response of the original filing of December 13, 2002. Claims 1-20 are pending and have been considered below.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-4 12, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Imai (US 5512977).

Claim 1: Imai discloses a copying machine capable of prohibiting illegal copying of document comprising:

- a. An encryption key-creating unit for creating an encryption key when acquisition unit acquires an image signal (encryption generating means capable of generating an encryption key) (column 2, lines 15-17);
- b. An encrypting unit for encrypting the image signal with the encryption key created by said encryption key creating unit (encryption generating means capable of generating an encryption key for enciphering the information read by information reading means) (column 2, lines 15-20);
- c. A writing unit for writing the encryption key into memory (and an information writing means writing the information enciphered on memory) (column 2, lines 20-25),

Wherein said image said image forming unit forms an image based on the image signal encrypted by said encryption on the sheet (column2 lines 5-25).

Claims 2, 12: Imai discloses a copying machine capable of prohibiting illegal copying of document as in claim 1 above, and further comprising:

- a. An image-reading unit for reading the image formed on the sheet (information reading means for reading the information from the first or fourth medium) (column 2, lines 13-15);
- b. A memory-reading unit for reading encryption key from memory when image-reading unit reads the image (the encryption key generated by the encryption key generating means is store in the first) (column 3, lines 20-25); and
- c. A decrypting unit for decrypting the image signal of the image read by said image reading unit, with the encryption key read by said memory reading unit (and the deciphering means decipheres the information read by the information reading means utilizing as decryption key the encryption key store in the memory) (column 3, lines 20-25),

Wherein said image forming unit forms an image based on the image signal decrypted by said decrypting unit on a sheet (column 3, lines 10-25).

Claim 3: Imai discloses a copying machine capable of prohibiting illegal copying of document as in claim 1 above, and further discloses:

Acquiring/creating unit for acquiring or creating information about the image encrypted with the encryption key, wherein said writing unit writes the encryption key and the information acquired or created by said information acquiring/creating unit into the same

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memory, or different memories (an information writing means for writing, printing, describing, storing information in to memory (column 2, lines 20-25).

Claims 4, 13: Imai discloses a copying machine capable of prohibiting illegal copying of document as in claim 2 and 12 above, and further discloses that the memory reading unit reads the encryption key and information about the image encrypted with the encryption key from the same memory, or different memories when said image reading unit reads the image (encryption key generated by encryption key generating means is stored in the first memory, and the deciphering means deciphers the information read by the information reading means) (column 3, lines 20-25), and said image forming apparatus further comprises a display unit for displaying the information read by said memory reading unit(the storage location in the memory in which the encryption key is stored is displayed on the displaying means(column3, lines 50-55).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5-11, 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imai (US 5512977) in view of Harada et al (US 20030007640).

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Claims 5, 14: Imai discloses an apparatus capable of prohibiting illegal copying of file as in claims 4 and 13 above, but does not explicitly disclose that the reading unit includes the number of times the image was formed. However Harada et al discloses a similar apparatus, which includes content storage unit with pre-stores usage condition in correspondence with the content (page 11, paragraph 215). The usage condition is permitted a permitted number of playback times. The permitted number of playback times imposes limitation on the total number of times that the user is permitted to play back the stored content that correspond to the usage condition (page 11 paragraph 216). The condition storage unit shows (writes) a permitted playback (image formed) number of time (page 2, paragraphs 24, 214-240 and fig 13). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the number of times a copy was made in the copying machine of Iman. One would have been motivated to include the number of copy in order to determine when the authorized limit was reached.

Claims 6, 15: Imai and Harada et al disclose an apparatus capable of prohibiting illegal copying of file as in claim 5, and 14 above, and Harada et al further discloses that the condition storage unit shows (writes) a permitted playback (image formed) number of time (page 2, paragraphs 24, 214-240 and fig 13). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the number of time a copy was made in the copying machine of Iman. One

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would have been motivated to include the number of copy in order to inhibit or avoid illegal copying.

Claims: 7, 16. Imai and Harada et al disclose an apparatus capable of prohibiting illegal copying of file as in claims 6 and 15 above, and Imai further discloses that the control circuit accepts input data from the keyboard and display necessary data on the display (column 10, lines 55-60).

Claims 8, 17: Imai and Harada et al disclose an apparatus capable of prohibiting illegal copying of file as in claim 5 and 14 above, and Harada et al further discloses that the condition storage unit shows (writes) a permitted playback (image formed) number of time and a condition judgment unit which judges to play back the content only when the number of times of actual playback (image formed) of the content by the payback unit (image processing unit) is equal to or less than the permitted number of times (page 2, paragraphs 24, 214-240, and fig 11). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the number of time a copy was made in the copying machine of Iman. One would have been motivated to include the number of copy in order to determine when the authorized limit was reached.

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Claims 9, 18: Imai discloses an apparatus capable of prohibiting illegal copying of file as in claim 4 and 13 above, but does not explicitly disclose that the reading unit includes a period. However Harada et al discloses a similar apparatus in which the condition storage unit shows a permitted playback (image formed) period and a condition judgment unit which judges to determine if the date and time at which the content is to be played back by the playback unit is within the permitted playback period and then (page 2, paragraphs 24, 243-250 and fig 12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the number of times a copy was made in the copying machine of Iman. One would have been motivated to include a permitted period in order to determine when the authorized limit was reached.

Claims 10, 19: Imai discloses an apparatus capable of prohibiting illegal copying of file as in claim 4 and 13 above, but does not explicitly disclose that the identifier read by the memory reading unit includes the identifier stored in the storing unit. However Harada et al discloses a similar apparatus in which the record/playback (image processing) device includes a condition storage unit operable to store usage condition information (identifiers) showing a permissive condition for use of the content; and a condition judgment unit operable to judge whether use of the content is permitted according to the usage condition information (page 1, paragraph 12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention

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was made to include an identifier in the copying machine of Iman. One would have been motivated to include the identifier in order to prevent illegal copying.

Claims 11, 20: Imai discloses an apparatus capable of prohibiting illegal copying of file as in claim 4 and 13 above, but does not disclose that the code inputted by the input unit and the code read by the reading unit are identical. However Harada et al discloses a similar apparatus which further discloses the record/playback (image processing) device includes a condition storage unit operable to store usage condition information (identifiers) showing a permissive condition for use of the content; and a condition judgment unit operable to judge whether use of the content is permitted according to the usage condition information (page 1, paragraph 12). In case of receiving the read instruction from the input unit as well the information indicating of successful authentication from the authentication unit, the control unit outputs a storage instruction to the title key-generating unit of the decryption unit (page 15, paragraph 309). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a code in the copying machine of Iman. One would have been motivated to include the code in order to prevent illegal copying.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- a. Takehisa (US 6343281) discloses a device and method for preventing fraudulent copies.
- b. Ibaraki et al (US 6434 538) discloses a data control method for embedding data control.
- c. Fujihara et al (US 7050604) discloses an image data protection technique.
- d. Nagashima et al (US 5581613) discloses a color image processing apparatus and method.
- e. Michael et al (US 5881281) discloses a method and apparatus for protection method in computer system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fatoumata Traore whose telephone number is (571) 270-1685. The examiner can normally be reached Monday through Thursday from 7:30 a.m. to 4:30 p.m. and every other Friday from 7:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim W. Myhre, can be reached on (571) 272 6722. The fax phone number for Formal or Official faxes to Technology Center 2100 is (571) 273-3800. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 274-1685.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-2100.

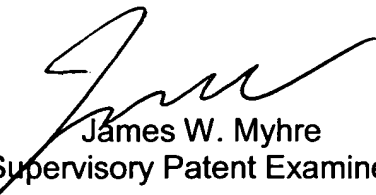
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January 9, 2007


James W. Myhre
Supervisory Patent Examiner